

### **REMARKS/ARGUMENTS**

Claims 1-36 are pending in the present application.

This Amendment is in response to the Office Action mailed November 17, 2008. In the Office Action, the Examiner rejected claims 21-36 under 35 U.S.C. §101 and allowed claims 1-20. Reconsideration in light of the remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 101***

In the Office Action, the Examiner rejected claims 21-36 under 35 U.S.C. §101. Applicant respectfully disagrees for the following reasons.

1. Claims 31 and 35:

In the Office Action, the Examiner contends that Claims 31 and 35 are nominally drawn to an “apparatus” comprising “means for storing, means for selecting, means for analyzing” (as in claim 31) means for receiving, means for providing feedback information and means for decoding (as in claim 35) are sub modules within the transmitter (120) and receiver (140) modules. The Examiner contends that the disclosure in paragraph [023] discloses that the transmitter 120 is a module and may be a software module, a hardware circuit, or a combination of both hardware and software. The Examiner makes a similar argument for the input/output module, a generator, and a decoder as belonging to the receiver 140 where the receiver may be a software module, a hardware circuit, or a combination of both hardware and software as disclosed in paragraph [025]. The Examiner concludes that each of the claims 31 and 35 recites a software module and therefore is a computer program. The Examiner then contends that are non-statutory as these claims are directed toward “software per se”.

Applicant respectfully disagrees and submits that the Examiner has made several errors in the arguments and the rejections as discussed below.

a) A “means for” structure is not a data structure or a computer program per se:

The Examiner relies on Section 2106.01 in MPEP to reject the claims. However, Section 2106.01 is not applicable for the instant case. Section 2106.01 is related to “descriptive material” such as a data structure or a computer program which imparts functionality when employed as a computer component.

In claims 31 and 35, the elements “means for storing”, “means for selecting”, and “means for providing” (for claim 31), and “means for receiving”, “means for providing”, and “mean for decoding” (for claim 35) are not data structures or merely computer programs per se. A data structure is a physical or logical relationship among data elements. Data structures are non-statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760. MPEP 2106.01. I (FUNCTIONAL DESCRIPTIVE MATERIAL: “DATA STRUCTURES” REPRESENTING DESCRIPTIVE MATERIAL *PER SE* OR COMPUTER PROGRAMS REPRESENTING COMPUTER LISTINGS *PER SE*). However, none of the above elements in the rejected claims is a data structure that relates to data elements. For example, the “means for storing” is not merely a data structure to relate the relationship between the default stream and the MD coding. The “means for storing” is a physical structure that stores the default stream which is coded by the MD coding. Similarly, they are not computer programs per se either. A computer program per se is a listing of instructions, a source code, or a series of instructions. A computer program per se is incapable of being executed by itself. Clearly, a “means for storing” or a “means for receiving” is not a computer program per se because they do not represent computer listings per se. Instead, they represent physical structures that have structural components and perform functional acts. For example, “means for storing” represents a buffer; “means for selecting” represents the selector and packetizer; “means for providing the transmission status” represents the feedback analyzer; the “means for receiving” represents an I/O module; “means for providing feedback information” represents a feedback generator; and “means for decoding” represents a decoder. All of these elements represent physical structures that can perform functional acts.

The Examiner merely asserts that the transmitter and receiver are software modules that are not tied to a particular machine (Office Action, page 3). However, even if they are software modules, they are not data structure or program listings as discussed above.

b) “Tying to a particular machine” requirement:

The Examiner relies on the “tying to a particular machine” requirement in rejecting claims 31 and 35. However, this requirement is only applicable for a process claim or a method claim. It is not applicable for apparatus claims or claims that recited elements that have structural components or functional elements. Here, for example, the “means for storing” refers to the

buffer, which is a physical element having structure. Accordingly, the “tying to a particular machine” requirement is either not applicable or automatically satisfied by virtue of the physical elements of the claims.

c) The disclosure discloses alternative embodiments:

Even if the rejected claims may be interpreted as computer programs per se, Applicant does not claim only software modules. Paragraphs [023] and [025] disclose alternative embodiments. For ease of reference, paragraphs [023] and [025] are copied below.

“The media content 110 is any media content that is designed to transmit to a user or viewer. It may be a video sequence, an audio program, an audio-video content, a movie clip, etc. The transmitter 120 is a module located at a content delivery server to transmit the media content 110 to the receiver 140. **The transmitter 120 may be a software module, a hardware circuit, or a combination of both hardware and software.**”  
(Specification, Paragraph [023]. *Emphasis added.*)

“The receiver 140 is a module located at a client to receive the media content stream. **The receiver 140 may be a software module, a hardware circuit, or a combination of both hardware and software.** The receiver 140 sends the decoded media stream to the media player 150. The media player 150 is any player that can play or display the decoded media stream to a user or viewer 160 on an output device such as a display screen, an audio output, or any combination of output devices.”  
(Specification, Paragraph [023]. *Emphasis added.*)

As seen from the above excerpts, the disclosure states alternative embodiments using the connective OR (a software module, a hardware circuit, **or** a combination of both hardware and software.”. The use of the connective OR in conjunction with the serial comma indicates that there are alternative embodiments. The Examiner cannot force Applicant to claim only a specific embodiment when Applicant discloses alternative embodiments. Applicant does not have to claim all of the alternative embodiments. Applicant elects to claim the hardware circuit or a combination of both hardware and software which is clearly statutory.

2. Claims 21-30:

The Examiner contends that claims 21-30 are directed to non-statutory subject matter. The Examiner apparently repeated the same rejection as presented in the Office Action dated

May 21, 2008. This rejection has been addressed in the response filed on August 28, 2008.

Applicant respectfully requests the Examiner refer to the previous response.

Applicant reiterates the arguments presented in the previous response below.

The specification provides for alternative means. Paragraph [0074] recites:

“The ‘processor readable or accessible medium’ or ‘machine readable or accessible medium’ may include any medium that can store, transmit, or transfer information. Examples of the processor readable or machine accessible medium include an electronic circuit, a semiconductor memory device, a read only memory (ROM), a flash memory, an erasable ROM (EROM), a floppy diskette, a compact disk (CD) ROM, an optical disk, a hard disk, a fiber optic medium, a radio frequency (RF) link, etc.”  
(Specification, paragraph [0074]). *Emphasis added.*

Since there are alternative means, applicant may elect to claim any one of them. Claim 21 recites “a machine-accessible storage medium” which clearly embodies a storage medium, and not just any medium. A storage medium is clearly statutory. Several examples of a storage medium are provided in the specification such as an electronic circuit, a semiconductor memory device, a read only memory (ROM), a flash memory, an erasable ROM (EROM), a floppy diskette, a compact disk (CD) ROM, an optical disk, a hard disk (Specification, paragraph [0074]). Thus, claims 21-30 are directed to statutory subject matter.

Applicant further notes that Claims 21-30 are Beauregard-type claims which recite an article of manufacture that comprises a machine-accessible storage medium. A claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035; MPEP 2106.01.I. Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, **the claim remains statutory irrespective of the fact that a computer program is included in the claim**. MPEP 2106.01.I (Emphasis added.) Such a Beauregard claim has been determined statutory. *In re Nuijten*, 500 F.3d 1346 (Fed. Cir., 2007) (“It has been the practice

for a number of years that a 'Beauregard Claim' of this nature be considered statutory at the USPTO as a product claim.""). Accordingly, claims 21-30 are statutory.

Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §101 be withdrawn.

**Allowable Subject Matter**

In the Office Action, the Examiner allows claims 1-20. Applicant acknowledges the Examiner's allowance of claims 1-20. In light of the above remarks, Applicant believes that claims 21-36 are allowable.

***Conclusion***

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: March 10, 2009

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